



3673 \$
#4/election
G4
3/28/02

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: The Commissioner of Patents and Trademarks, Washington, DC 20231 on the date indicated below.

Jodi A. Calderon
Jodi A. Calderon

Date: 3-14-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Daniel Geier

Art Unit: 3673

Serial No.: 09/713,659

Examiner: Singh, Sunil

Filed: November 15, 2000

For: *Dual Amplitude Exciter*

RESPONSE TO RESTRICTION REQUIREMENT

The Commissioner of Patents and Trademarks
Washington, D.C. 20231

RECEIVED
MAR 27 2002
GROUP 3600

Dear Sir:

In response to the Restriction Requirement mailed January 29, 2002, applicant hereby provisionally elects Group III, claims 15-19, for prosecution in the above-captioned patent application.

This election is *with* traverse for multiple reasons.

First, the Examiner incorrectly divides the claims into three groups when, at most, they can be divided into two groups. Claims 12 and 13 are directed toward an exciter assembly for a vibratory roller, not a compacting roller with vibrating means as alleged by the Examiner. They therefore should be grouped with Group 1. Claims 1, 13, 14-19, and 27-30 are directed toward a compacting roller with an exciter assembly or to a method of its construction and should be grouped together. Hence, Group II should be eliminated as a separate grouping. It certainly is not related to both Groups I and III as a combination/subcombination.

Turning now to the rationale behind the restriction requirement, while the Examiner's proposed groupings made available do differ from one another as judged by the first independent claim in each Group, they do not exhibit distinctness such that a search and examination will be burdensome. For example, the Examiner states that the claims of Group I are distinct from the claims of Group II because Group II lacks first and second angular positions of a free weight for adding or detracting eccentricity to the fixed weight. However, at least some claims of Group II claim a method of assembling such an apparatus: claim 20 of Group II claims "mounting first and second free swinging eccentric weights on said exciter shaft adjacent respective ends of said fixed weight so as to be rotatable a limited amount relative to said exciter shaft . . ." In other words, the rotation of a free weight varies between free swinging positions and a position of limitation imposed by the fixed weight. The free weight therefore can be said to have at least two angular positions relative to the fixed weight, and claims from Group II are therefore generic to but not distinct from the claims of Group I on that basis. In addition, since both Groups I and II claim axial restraint of the free swinging weight, it would appear to be easier to group them together than to separate them for purposes of searching and examination.

The Examiner found Group III claims to be distinct from the Group II claims based on the same lack of first and second angular positions. As discussed above, however, at least claims 20-30 of Group II are not distinct on that basis since claims 20 – 30 share a generic claim to limited rotation of free weights as found in claimed in Group III as first and second angular positions. Furthermore, claims 15 and 16 of Group III specify restraint of axial movement just as in Groups I and II.

Finally, the Group I claims are considered by the Examiner to be distinct from Group III claims for lack of axial restraint, but as just discussed, Group III claims 15 and 16 do discuss restraint of substantial axial movement. Group I and III also claim the function of added/detracted eccentricity due to the rotation of a free weight and are logically examined together.

In conclusion, the Examiner's concerns with regard to the presence or absence of the first and second angular positions and the presence or absence of axial restraint of the free weight in the claim groups are misplaced. Not only does each of these elements appear throughout the three groups, they are also not distinct from one another.

In addition, even if one were to accept the Examiner's statements at face value (which would be a mistake for the reasons cited above) the Examiner has failed to meet his burden of justifying restriction between Groups II and III by showing that they have a separate status in the art:

To support a requirement for restriction, both two-way distinctness *and reasons for insisting on restriction* are necessary, i.e., separate classification, status, or field of search. See MPEP §808.02.

(MPEP §806.05(c)). MPEP §808.02 states, in pertinent part:

Where the related inventions as claimed are shown to be distinct under the criteria of MPEP Section 806.05(c) - Section 806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(A) Separate classification thereof: This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) A separate status in the art when they are classifiable together: Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) A different field of search: Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

In the present case, the Examiner has failed to meet any of the four requirements (A), (B), or (C) identified above with respect to Groups II and III. His statement to the contrary in paragraph 5 of the Office Action is incorrect because Groups II and III are classified in the same class and subclass.

Finally, the PTO requires the examiner to examine an entire application on the merits, even if it includes claims to independent or distinct inventions, if a search and examination of the entire application can be made without serious burden. (MPEP §803). In the present case, the Examiner admits that Groups II and III are classified in the same class and subclass of the PTO's classification system. Applicant fails to recognize how searching the same class and subclass for an invention that is clearly closely related to the elected invention can place *any* significant additional burden on the inventor. Hence, at a minimum, the claims of Group II should be considered with the claims of Group III.

In light of the forgoing, applicant requests that the restriction requirement be withdrawn in its entirety and that all claims be considered. At a minimum, at least claims 27-30 and, more properly, all claims of Group II, should be considered along with the claims of the elected Group III.

Applicant reserves the right to file a divisional application for the subject matter of the non-elected claims at a later date should the restriction requirement be made final and affirmed on petition.

A check in the amount of \$110.00 is enclosed in payment of the fee associated with a request for a one-month's extension of time, which applicant hereby makes. Should the Examiner consider any additional fees to be payable in conjunction with this or any future communication, the Director is authorized to direct payment of such fees, or credit any overpayment to Deposit Account No. 50-1170.

Respectfully submitted,



Timothy E. Newholm
Registration No. 34,400

Dated: March 14, 2002

BOYLE FREDRICKSON NEWHOLM
STEIN & GRATZ S.C.
250 E. Wisconsin Ave., Ste. 1030
Milwaukee, WI 53202
Telephone: (414) 225-9755
Facsimile: (414) 225-9753

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

FEE TRANSMITTAL for FY 2002

Patent fees are subject to annual revision.

☐ Applicant Claims small entity status See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$110)

Complete if Known

Application Number 09/713,659
 Filing Date November 15, 2000
 First Named Inventor Geier
 Examiner Name Singh
 Group Art Unit 3673
 Attorney Docket No. 7.035

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☒ Deposit AccountDeposit
Account
Number

50-1170

Deposit
Account
Name

Boyle, Fredrickson, Newholm, Stein & Gratz S.C.

The Commissioner is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments☐ Charge any additional fee(s) during the pendency of this application☐ Charge fee(s) indicated below, except for the filing fee

to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Fee (\$)	Small Entity Fee Code	Fee (\$)	Fee Description	Fee Paid
101	740	201	370	Utility filing fee	
106	330	206	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	160	214	80	Provisional filing fee	

SUBTOTAL (1) (\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	-20**=	X	
Multiple Dependent	-3**=	X	

Large Entity Fee Code	Fee (\$)	Small Entity Fee Code	Fee (\$)	Fee Description
103	18	203	9	Claims in excess of 20
102	84	202	42	Independent claims in excess of 3
104	280	204	140	Multiple dependent claim, if not paid
109	84	209	42	**Reissue independent claims over original patent
110	18	210	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

** or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee	Small Entity Fee	Fee	Fee	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for <i>ex parte</i> reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	110
116	400	216	200	Extension for reply within second month	
117	920	217	460	Extension for reply within third month	
118	1,440	218	720	Extension for reply within fourth month	
128	1,960	228	980	Extension for reply within fifth month	
119	320	219	160	Notice of Appeal	
120	320	220	160	Filing a brief in support of an appeal	
121	280	221	140	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,280	241	640	Petition to revive - unintentional	
142	1,280	242	640	Utility issue fee (or reissue)	
143	460	243	230	Design issue fee	
144	620	244	310	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Processing fee under 37 CFR 1.17(q)	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	740	246	370	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	740	249	370	For each additional invention to be examined (37 CFR § 1.129(b))	
179	740	279	370	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3)

(\$110)

SUBMITTED BY

Complete (if applicable)

Name (Print/Type)	Timothy E. Newholm	Registration No. (Attorney/Agent)	34,400	Telephone	(414) 225-9755
Signature				Date	March 14, 2002

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant commissioner for Patents, Washington, DC 20231.